

PATENT
Atty. Dkt. No. RO999-114
MPS Ref. No.: IBM/99/114.Y1

REMARKS

This is intended as a full and complete response to the Office Action dated June 3, 2005, having a shortened statutory period for response set to expire on September 3, 2005. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-42 are pending in the application. Claims 1-42 remain pending following entry of this response.

Claim Rejections - 35 U.S.C. § 103

Claims 1-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Kanno et al.* (USPN 6,526,424 B2 - filed on 03/1998, hereinafter *Kanno*) in view of *Anupam et al.* (USPN 6,535, 912 131 - filed 08/1999, hereinafter *Anupam*). Applicants respectfully traverse the rejection.

Applicants previously submitted a 37 C.F.R. Sec. 1.131 Declaration with an attached exhibit (Exhibit A), stating "In view of Exhibit A, the invention of pending claims 1-42 was conceived prior to August 31, 1999..." The Examiner takes the position that the evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the *Anupam*. However, Applicants respectfully submit that the exhibit (Exhibit A) submitted with the 1.131 Declaration is sufficient to establish a conception of the invention prior to the effective date of *Anupam*. Support for the claimed invention is found in the exhibit as described below.

With respect to independent claim 1, the claim describes a method of verifying a bookmark.

Support for "storing, as a bookmark in at least a first data structure, a first network information address of a document having content" is provided in the submitted exhibit at least at page 2, paragraph 4.

Support for "identifying embedded network information addresses within the content" is provided in the submitted exhibit at least at page 2, paragraph 4.

Support for "automatically searching, at a predefined frequency, for the document located at the first network information address to determine whether the first network

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information address is retrievable" is provided in the submitted exhibit at least at page 2, paragraphs 4-5.

Support for "wherein if the first network information address is retrievable, determining whether the document has been moved to a second network information address different from the first network information address" is provided in the submitted exhibit at least at page 2, paragraph 2 and 4.

Support for "wherein if the first network information address is not retrievable, making the identified embedded network information addresses available to a user via the stored bookmark" is provided in the submitted exhibit at least at page 2, paragraph 4.

With respect to independent claim 19, the claim describes "a computer implemented automated method for maintaining bookmarks".

Support for "storing, in a data structure, a bookmark to a network information address of a document having content" is provided in the submitted exhibit at least at page 2, paragraph 1.

Support for "scanning the content for one or more embedded network information addresses, wherein if any embedded network information addresses are found, storing the embedded network information addresses" is provided in the submitted exhibit at least at page 2, paragraph 4.

Support for "periodically determining whether the network information address has changed" is provided in the submitted exhibit at least at page 2, paragraphs 4-5.

Support for "wherein if the network information address has changed, determining whether a forwarding network information address is provided" is provided in the submitted exhibit at least at page 2, paragraphs 2 and 4.

Support for "if not, associating the bookmark with the embedded network information addresses" is provided in the submitted exhibit at least at page 2, paragraph 4.

With respect to independent claim 27, the claim describes "a signal bearing medium for storing a program that, when executed by a computer performs an operation".

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Support for "downloading a bookmark network information address of a document having content" is provided in the submitted exhibit at least at page 2, paragraphs 1 and 4.

Support for "storing the bookmark network information address in a data structure" is provided in the submitted exhibit at least at page 2, paragraphs 1 and 4.

Support for "(c) scanning the content for one or more embedded network information addresses, wherein if any embedded network information addresses are found, storing the embedded network information addresses in the data structure" is provided in the submitted exhibit at least at page 2, paragraph 4.

Support for "periodically determining whether the document is retrievable at the bookmark network information address" is provided in the submitted exhibit at least at page 2, paragraphs 4-5.

Support for "if the information is not retrievable at the bookmark network information address, determining whether a forwarding network information address is provided, wherein if the forwarding network information address is provided, replacing the bookmark network information address in the data structure with the forwarding network information address, and wherein if a forwarding network information address is not provided, generating a backup document containing the embedded network information addresses stored in the data structure" is provided in the submitted exhibit at least at page 2, paragraph 4.

Support for "if the document is retrievable at the bookmark network information address, determining whether the content has changed, wherein if the content has changed, repeating (c)" is provided in the submitted exhibit at least at page 2, paragraphs 2 and 4.

With respect to independent claim 35, the claim describes "a computer implemented method of managing bookmarks".

Support for "in response to a user request to bookmark a web page, storing a network address for the web page in a bookmark data structure" is provided in the submitted exhibit at least at page 2, paragraphs 1 and 4.

Support for "storing each hypertext link embedded in the web page in the bookmark data structure in a manner which associates the embedded hypertext links

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and the web page" is provided in the submitted exhibit at least at page 2, paragraphs 3 and 4.

Support for "associating a graphical bookmark object of a bookmark menu with the web page" is provided in the submitted exhibit at least at page 2, paragraphs 1 and 4.

Support for "determining whether the web page has moved to a different network address" is provided in the submitted exhibit at least at page 2, paragraphs 2-4.

Support for "if the web page has moved, determining whether an updated network address for the web page can be located" is provided in the submitted exhibit at least at page 2, paragraphs 2-4.

Support for "if the updated network address cannot be located, associating the graphical bookmark object with the stored embedded hypertext links of the web page" is provided in the submitted exhibit at least at page 2, paragraph 4.

With respect to independent claim 38, the claim describes "a method of maintaining access to information objects associated with a target document".

Support for "in response to a user request, storing a reference to the target document containing pointers to a plurality of information objects, whereby a user viewing the target document can access each of the plurality of information objects from the target document via the pointers" is provided in the submitted exhibit at least at page 2, paragraphs 1, 3, and 4.

Support for "maintaining the pointers in a data structure at a separate storage location from the target document" is provided in the submitted exhibit at least at page 2, paragraph 4.

Support for "automatically searching, at a predefined frequency, for the target document on the basis of the reference to determine whether the target document is retrievable" is provided in the submitted exhibit at least at page 2, paragraphs 4-5.

Support for "when the target document is not retrievable, automatically making the pointers available to a user via the stored reference, whereby the user has access to the plurality of information objects even though the target document is not retrievable" is provided in the submitted exhibit at least at page 2, paragraphs 3-4.

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Each of the pending dependent claims depends from one of the independent claims described above. Accordingly, the rejection is believed to be overcome for the reasons described above.

Examiner also states that the exhibit is silent about implementation or existence of prototype or product and that "proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose". Thus, Examiner appears to suggest that proof of reduction to practice is required to overcome the cited prior art.

However, Applicants submit that the date of invention can be established by showing conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent filing of the application. Specifically, 37 C.F.R. Sec. 1.131(b) states:

The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application.

Therefore, **actual reduction to practice is not required** and Applicant is not required to prove the existence of a prototype or product as suggested by the Examiner. Accordingly, the Applicants have satisfied the legal requirements to prove a prior date of invention.

Therefore, the claims are believed to be in condition for allowable, and allowance of the claims is respectfully requested.

Conclusion

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the primary references cited in the office action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

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Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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